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Serial No.: 10/629,432

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## REMARKS

In the Office Action dated February 24, 2004, the Examiner rejected claims 1-3, 5, 7-10, and 12-14 under 35 U.S.C. 102(e) "as being anticipated by Hausheer, USP 5910491". Specifically, the Examiner asserted that:

Note: the generic formula, and example 22, which is identical to the first species in claim 13. The claimed subject matter here does not appear in 08/436799. Requiring the substituents shown in the claims not rejected to be present on the benzo ring would make the claim free from rejection over the prior art.

Applicants respectfully traverse the Examiner's rejection.

Applicants have canceled claims 1-13. With respect to claim 14, Applicants have amended the claims to indicate that at least one of  $R^1$ ,  $R^2$ ,  $R^3$  and  $R^4$  is not H, a halogen, an alkyl group, an amino group or a nitro group. Hausheer does not disclose or suggest a method of treatment of a cancer patient or a leukemia patient with the compounds set forth in the present invention.

The Examiner has also rejected claims 1-14 under 35 U.S.C. 112, second paragraph, "as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention." Specifically, the Examiner indicated that:

1. The term "acyl" is indefinite. Does this embrace acids of S? P? As? What does the stem look like, i.e. if the acyl is e.g.  $RC(O)$ , what is R? In carboxylic acid acyls, does the carbon count include the carbon of the carbonyl?
2. The "carbonyloxy" group does not make sense. This has two valences (one at carbonyl, one at oxy), but it is for a monovalent radical.
3. While applicant may be his or her own lexicographer, a term in a claim may not be given a meaning repugnant to the usual meaning of that term. See *In re Hill*, 161 F.2d 367, 73 USPQ 482 (CCPA 1947). The meanings

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quoted by applicants are not the usual meaning at all. Alkyl is a group of the formula  $-C_nH_{2n+1}$ , as is set forth in such sources as Hack's Chemical Dictionary and Hawley's Condensed Chemical Dictionary, or any textbook of organic chemistry. As such it cannot have rings (see last line of page 6).

4. Claim 14 is vague. What kind of patient? The claim as it reads embraces any patient with any disorder, surely not applicants' intent. And, "effective" for what?

5. The last 4 choices in claim 6 are not provided for in claim 1. Thus, claim 1 has hydroxy but not Hydroxymethyl. Likewise first two choices in claim 4.

6. The last two choices in claim 4 are substituted amino groups not provided for in claim 1. Likewise in claim 6.

7. The last species in claim 14 is not provided for by claim 1.

Applicants have amended the claims to obviate the Examiner's rejections.

The Examiner also rejected claims 1-3,5,7-10,12-13 under the judicially created doctrine of obviousness-type double patenting "as being unpatentable over claims 1-14 of U.S. Patent No. 6150343". Specifically the Examiner asserted that:

Although the conflicting claims are not identical, they are not patentably distinct from each other because these claims are just slightly broader versions of the patent claims of the parent. The rejected claims all have the 10-OH feature required in the patent.

The Examiner further rejected claims 1-13 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6455699. Specifically, the Examiner indicated that:

Although the conflicting claims are not identical, they are not patentably distinct from each other because these claims are just slightly broader versions of the patent claims of the parent. The rejected claims all fall into either claim 1, claim 2, claim 3 or claim 4.

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Applicants respectfully traverse the Examiner's rejection. Claims 1-13 have been canceled, thereby obviating the Examiner's rejection.

With respect to the IDS noted by the Examiner and Canadian reference 2229252, the Applicants did not file that IDS. Applicants note that although the serial number set forth on the IDS form PTO/SB/08a matches the serial number of this case. The first named inventor and the Attorney Docket No. set forth on the form PTO/SB/08A do not.

As earlier authorized, the Commissioner of Patent hereby once again authorized to charge the fees (\$63.00) associated with the introduction of seven (7) new dependent claims in excess of 20 claims added in this Amendment to deposit account 02-1065.

In view of the above amendments and remarks, the Applicants respectfully requests that the Examiner, indicate the allowability of the Claims, and arrange for an official Notice of Allowance to be issued in due course.

Respectfully submitted,

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